

AMENDMENT UNDER 37 C.F.R. § 1.111
U. S. Application No. 10/086,362

REMARKS

Claims 1-23 are all the claims pending in the application, including new claims 22 and 23 added by the present Amendment.

In reply to the Response filed April 22, 2004, the Examiner withdrew the finality of the previous Office Action. Also, the prior art rejection has been removed. The status of the claims is the following.

Claims 11-21 have been allowed. Claims 1-10 have been rejected under 35 U.S.C. § 112, first paragraph, as being directed toward two different statutory classes of invention. The same claims are still rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant remains of the view that the Examiner is not properly examining the claims.

Claim 1 recites the structure of an embodiment of the invention, specifically the two pairs of conveyance rollers, and the detector that detects the leading edge of the photosensitive material. The Examiner states that claim 1 is a hybrid claim, because it contains language pertaining to both an apparatus claim and a method claim. However, claim 1 does not contain method steps and is not a hybrid claim. Claim 1 specifically recites a detector that detects the leading edge of photosensitive material, and nipping and releasing conveyance rollers, which provide nipping and releasing of at least the leading edge of the photosensitive material, based on the detector output. The claim describes an apparatus. In describing the apparatus, the claim also uses some language that describes how the apparatus works. A description of how the apparatus works is considered functional language.

Functional language does not itself render a claim improper, according to MPEP 2173.05(g). Functional language is often used in a claim when used in combination with an

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element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. In claim 1, the action of the conveyance rollers is described in functional language, but only in conjunction with the output of the detector. In other words, nipping and releasing of the rollers is based on the output of the detector.

Although some functional language is used along with the recited structure, the claims do not recite any method steps. Instead, claims 1-10 are directed to and recite an apparatus, including its various structural elements. The presence of functional language does not alter the status of claims 1-10 as apparatus claims. Therefore, Applicant submits that the rejection of claims 1-10 under 35 U.S.C. §112, first paragraph is improper and should be removed.

In response to the indefiniteness rejection, Applicant submits that the rollers are the claimed structure performing the action, and it is not necessary to recite in the claims the entire detail of how the action is performed according to §112. The controller that creates the nipping and releasing of the rollers does not need to be claimed. The Examiner's requirement to include any controller is essentially a requirement to claim a preferred embodiment. This is not required to meet requirements for patentability under §112. The Examiner states that structural limitations to support the functional language are needed to overcome the §112, second paragraph and rejection. Applicant submits that the recitation of the detector is sufficient as a structural support to control the nipping and releasing of the conveyance rollers.

The Examiner asserts that "the conveyance rollers themselves cannot perform the recited function without the control of a controller." However, as recited in claim 1, the nipping and releasing of the photosensitive material is done by the conveyance rollers. Further, this nipping and releasing is based on the output of the detector. Although a controller and/or other elements

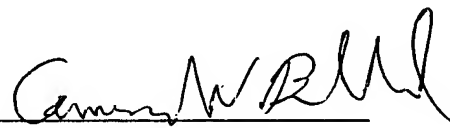
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could be used in conjunction with the claimed conveyance rollers and detector, Applicant submits that the claim does not have to recite any additional elements to be definite. Rather, the claims, as currently recited are definite.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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